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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,671	09/08/2003	Deborah A. Langer	3217	2146

7590 01/09/2008
THE LUBRIZOL CORPORATION
Patent Administrator
Mail Drop 022B
29400 Lakeland Boulevard
Wickliffe, OH 44092-2298

EXAMINER

GOLOBOY, JAMES C

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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01/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/657,671

Applicant(s)

LANGER ET AL.

Examiner

James Goloboy

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5, 8-11, 15-17, 19, 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,5,8-11,15-17 and 19 is/are allowed.
- 6) ☒ Claim(s) 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's declaration filed 9/10/07 overcomes the rejections of claims 1, 5, 8-11, 15-17, 19, and 22 set forth in the office action mailed 6/19/07. A new ground of rejection for claim 22 is set forth below.

Claim Rejections - 35 USC § 103

2. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cahoon (U.S. Pat. No. 5,484,542) in view of Lynn (Surfactants, in Kirk-Othmer Encyclopedia of Chemical Technology, posted online 12/4/2000, and retrieved from the internet at <http://mrw.interscience.wiley.com/emrw/9780471238966/kirk/article/surflynn.a01/rel0001/html> on 1/2/2008, p. 27).

In column 100 lines 35-36, Cahoon discloses emulsions that can be water-in-oil emulsions. In column 101 lines 25-52 Cahoon discloses a method of preparing the emulsion, comprising mixing additives with oil and water. In column 100 line 62 and columns 103-104 Cahoon discloses that a suitable additive is a thickener, and in columns 101-103 discloses that the emulsion also advantageously comprises an emulsifier. In column 101 lines 43-46 Cahoon discloses that the mixing is often carried out at a temperature of below 50° C, overlapping the range recited in step B of claim 22. The differences between Cahoon and the currently presented claims are:

i) Cahoon discloses the addition of an emulsifier, but does not disclose the HLB of the emulsifier.

ii) Cahoon does not disclose the pressure at which the mixing is carried out.

With respect to i), Lynn discloses on page 27 that surfactants with an HLB of 3-6, within the range recited for component (c) of claim 22, are useful as water-in-oil emulsions.

With respect to ii), it is the examiner's position that Cahoon's lack of disclosure of the pressure at which the mixing is carried out implies that the process is carried out at atmospheric pressure, meeting the limitations of claim 22. Additionally, it would have been obvious to one of ordinary skill in the art to carry the mixing out at atmospheric pressure as other pressures would require equipment for adjusting the pressure, increasing the cost of the process.

It would have been obvious to one of ordinary skill in the art to use an emulsifier with an HLB between 3 and 6 in forming the water-in-oil emulsion of Cahoon, as Lynn teaches that such emulsifiers are effective in forming water-in-oil emulsions.

Allowable Subject Matter

3. Claims 1, 5, 8-11, 15-17, and 19 are allowed. Applicant has submitted a declaration by Filippini, dated 9/7/07, unequivocally stating the subject matter of US PG Pub. No. 2004/0176263 was the declarant's own work. This declaration is sufficient to disqualify the '263 publication as prior art under 35 USC 102(e) and therefore overcomes the rejection set forth in the office action mailed 6/19/07. See MPEP 716.10.

Cahoon (discussed in paragraph 2 above), discloses a water-in-oil emulsion comprising water, oil, a thickener, and an additive, but gives no teaching or suggestion as to the Brookfield Viscosity of the emulsion. Stewart (U.S. Pat. No. 4,948,521)

discloses an emulsion containing a thickener, with a viscosity of between 2000 and 4000 cps, but only discloses oil-in-water emulsions, contrary to the water-in-oil emulsions presently claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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